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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,147	10/27/2003	Nicholas Want	AMD-104US	3026
23122	7590	08/05/2005	EXAMINER	
RATNERPRESTIA			CHAN, KO HUNG	
P O BOX 980			ART UNIT	
VALLEY FORGE, PA 19482-0980			PAPER NUMBER	

3632

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,147

Applicant(s)

WANT ET AL.

Examiner

Korie H. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 24-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-23, 32 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/10/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23 and 32, drawn to an apparatus or assembly for hanging, classified in class 248, subclass 340.
- II. Claims 24-31, drawn to method of hanging medical device , classified in class 604, subclass 322.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product or the hanger as claimed can be used in a materially different process of using that product such as using the hanger as a handle to support plastic grocery bags.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Joshua Cohen on March 10, 2004 a provisional election was made without traverse to prosecute the invention of I, claims 1-23 and 32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-31 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

DETAILED ACTION

Claim Objections

Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The entire recitation of claim 11 is found in claim 1 from which it depends.

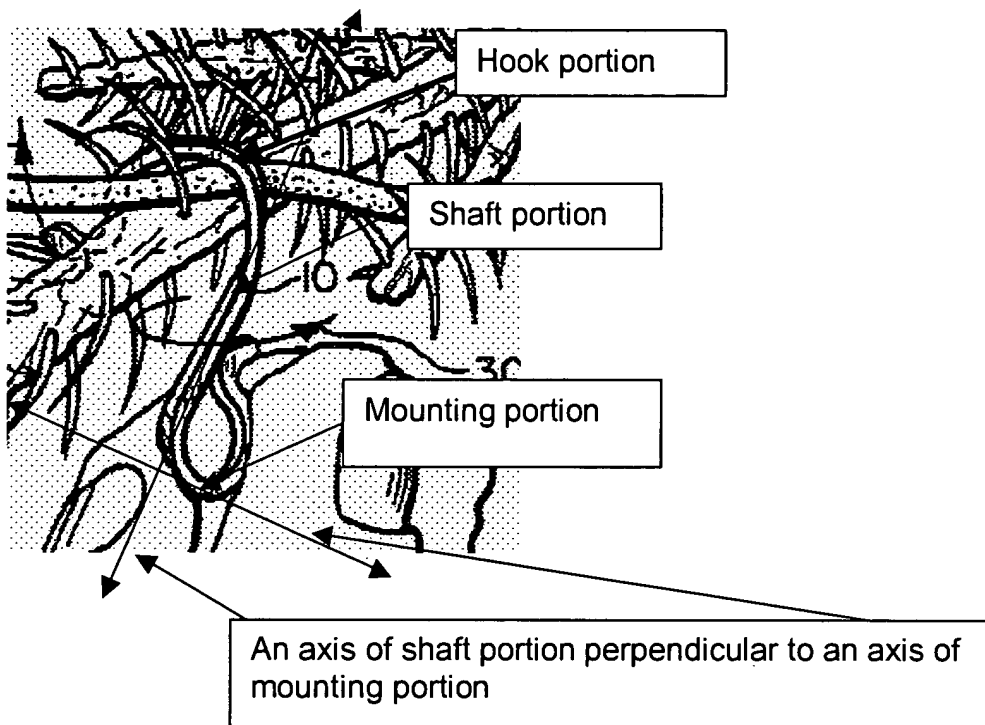
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

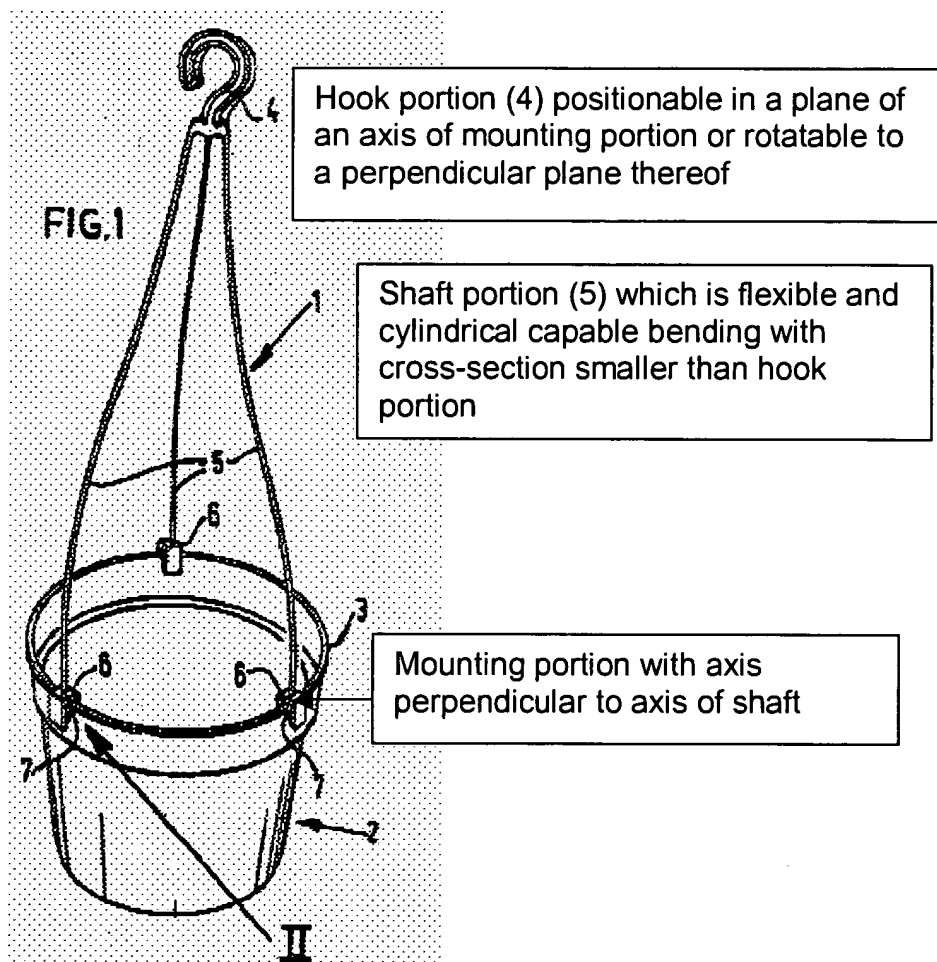
Claims 1-3 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Swenson et al (US patent no. 5,575,446). Swenson disclosed all the claimed features of applicant's invention as demonstrated below.



Regarding applicant's intended use language set forth in the preamble "for medical device" such as "a fluid recovery system" as in claim 9 or "thoracic cavity drainage system" is not accorded with patentable weight, since a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

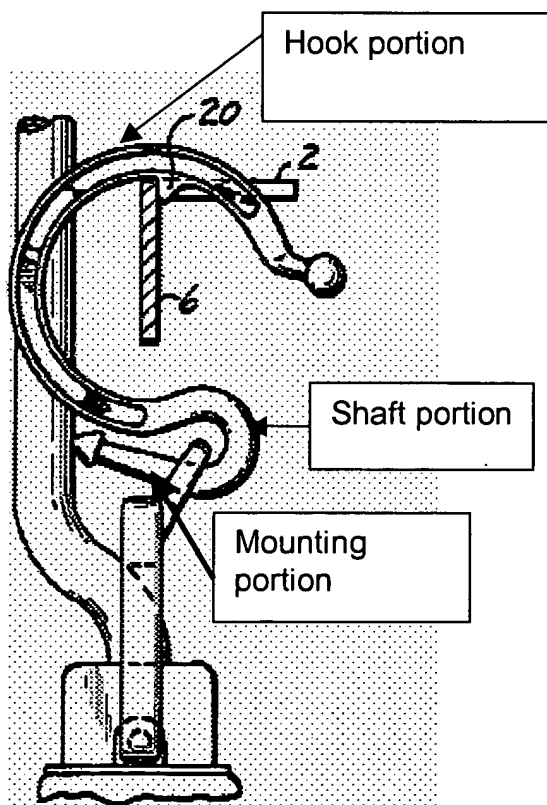
In this case, Swenson's hanger is capable of performing the intended use of supporting a medical device of the thoracic cavity drainage system type.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wijsman (US patent no. 4,440,371). Wijsman disclosed all the claimed features of applicant's invention as demonstrated below.



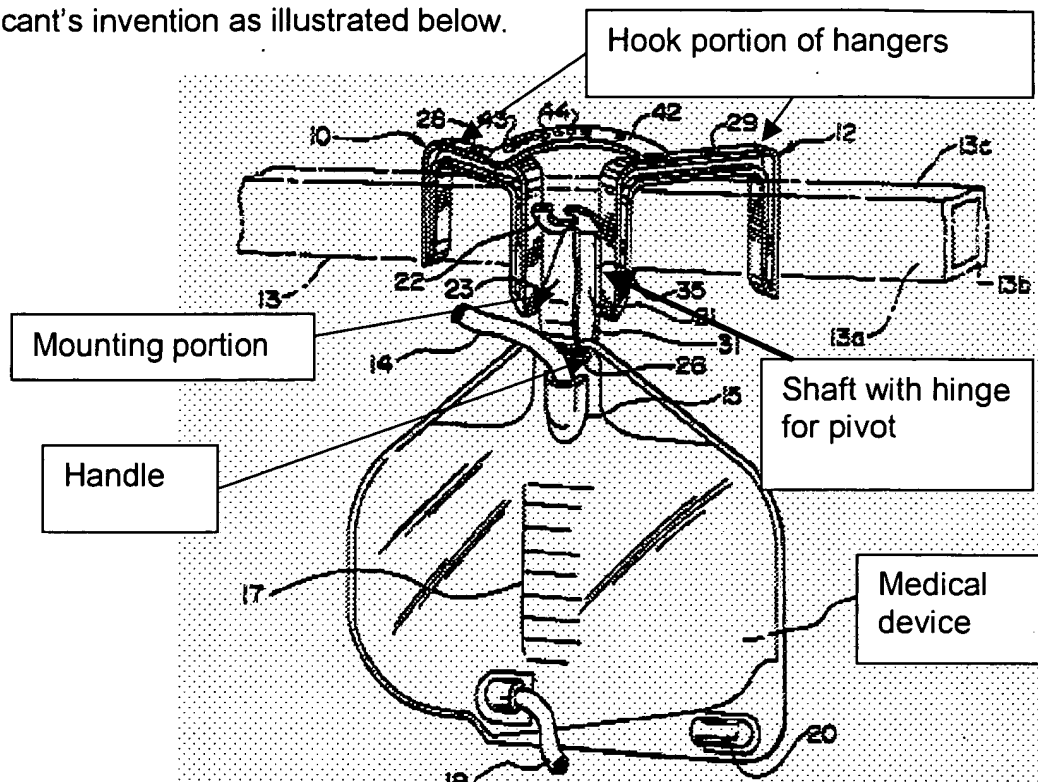
Again regarding applicant's intended use language set forth in the preamble "for medical device" such as "a fluid recovery system" as in claim 9 or "thoracic cavity drainage system" is not accorded with patentable weight. Wijsman's hanger is capable of performing the intended use function claimed.

Claims 23 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Day (US patent no. 4,219,177). O'Day discloses an assembly configured to be hung from a support (2), the assembly comprising: a medical device (drainage container); a handle (11, figure 1) coupled to the medical device and configured for grasping the medical device, the handle defining at least one aperture (10); and at least one hanger comprising a shaft (intermediate curved portion), a mounting portion (17) coupled to an end portion of the shaft and coupled to the handle; and a hook portion (15) positioned at an opposite end portion of the shaft and configured for hanging from the support; wherein the hanger is pivotable with respect to the handle, thereby facilitating deployment and retraction of the hanger with respect to said handle; and wherein at least a portion of the hanger extends into the aperture in the handle.



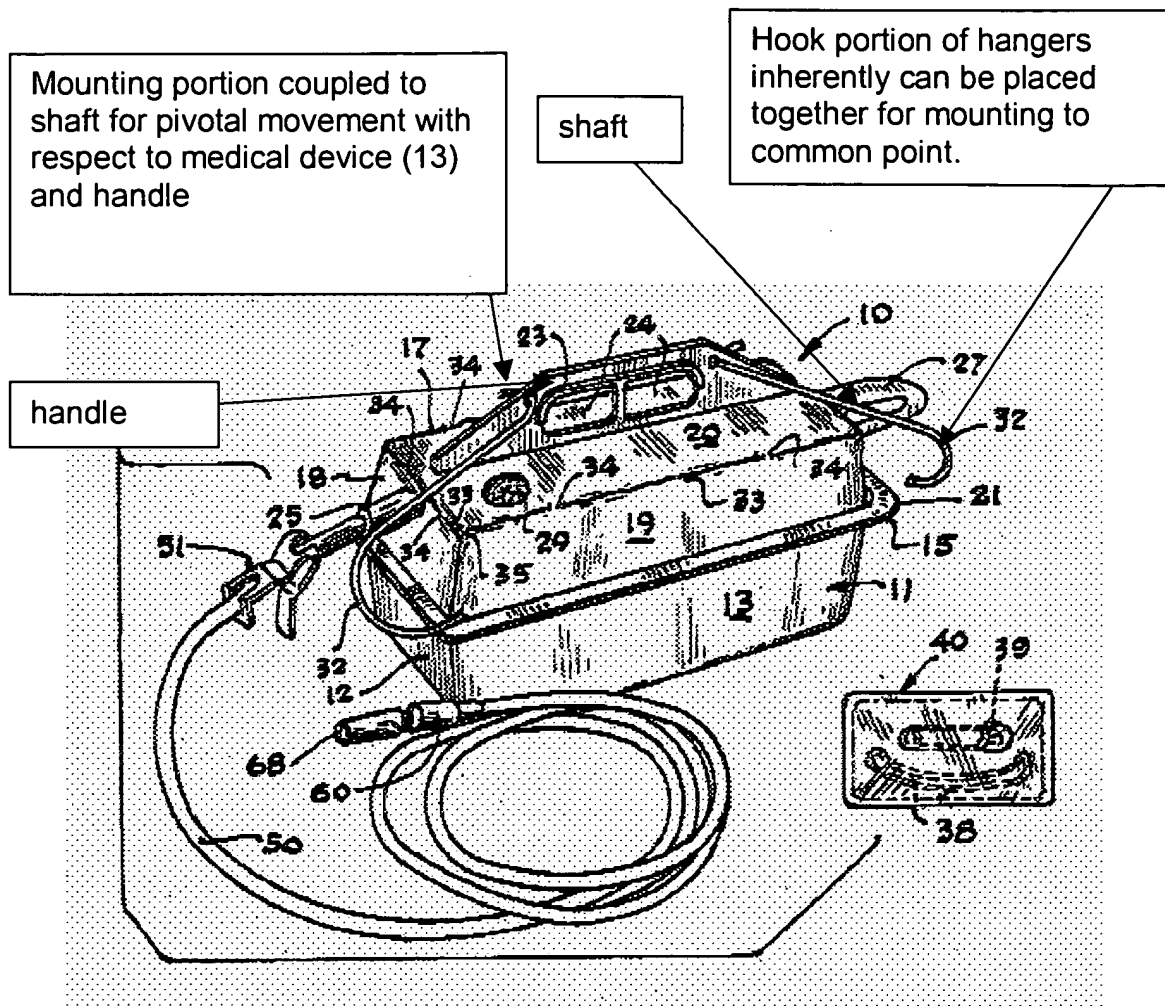
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Claims 13-15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhodes (US patent no. 5,373,799). Rhodes disclosed all the claimed features of applicant's invention as illustrated below.



Claims 19, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Chittenden et al (US patent no. 3,690,315). Chittenden et al disclosed all the claimed features of applicant's invention as illustrated below.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chittenden et al (US patent no. 3,690,315) in view of Swenson et al (US patent no. 5,575,446). Chittenden et al disclosed all the claimed features of applicant's invention except for the hook portion rotate with respect to mounting portion. It would appear Chittenden's wire hanger would be capable of twisting such that the hook portion and the mounting portion would be rotatable relative to one another. Nevertheless, twisting hook portion relative to the mounting portion is old and well-known in the art depending on the material made as demonstrated by Swensen for mounting purposes. It would have been obvious to one of ordinary skill in the art to have made Chittenden's hanger of bendable or rotatable material for mounting purposes as taught by Swensen.

Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of record demonstrate hook hangers of similar type.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Korie H. Chan
Primary Examiner
Art Unit 3632

khc
August 2, 2005